

O/0553/26

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION
NO. WO0000001668629 DESIGNATING THE UK

IN THE NAME OF

FOKUS BILGISAYAR SANAYI VE TICARET LIMITED SIRKETI

FOR THE FOLLOWING TRADE MARK:

PERFORMONSTER

IN CLASS 9

AND

OPPOSITION THERETO UNDER NUMBER 436765

BY

MONSTER ENERGY COMPANY

Background and Pleadings

1. The international registration shown on the cover page of this decision (“the IR”) was registered on 11 April 2022 in the name of FOKUS BILGISAYAR SANAYI VE TICARET LIMITED SIRKETI (“the Holder”). With effect from the same date, the Holder designated the UK as a territory in which it sought to protect the IR pursuant to the Protocol to the Madrid Agreement. Protection is sought for the following goods:

Class 9: Computers, notebook computers, laptop computers, tablet computers, computer mice, mouse pads [computer peripheral], laptop carrying cases, sleeves for laptops, notebook computer carrying cases, cases adapted for notebook computers.

2. On 10 October 2022, Monster Energy Company (“the Opponent”) opposed the application to protect the IR in the UK, based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under section 5(2)(b) of the Act, the Opponent claims that the marks are similar, and the goods/services are identical or similar, leading to a likelihood of confusion. In support of its opposition under this ground, it relies upon the trade mark registrations set out below. Whilst the marks stand registered for a broad range of goods and services, for the purposes of this opposition, the Opponent only relies upon those specifications outlined below:

UKTM no. 3254983

MONSTER

Filed on 6 September 2017 and registered on 19 January 2018.

Class 9: Protective covers and cases for cell phones;¹ Protective ear coverings, namely helmets; eye glasses, eye glass cases, sunglasses, sunglass cases.

¹ Although these terms formed part of the original registration, they were surrendered on 4 July 2025 during separate, unrelated proceedings (no. 507168). Nevertheless, the earlier right remained valid in respect of these terms as at the date of the opposition and the Opponent is therefore still entitled to rely on them for the purposes of these proceedings.

Class 18: All-purpose sport bags; all-purpose carrying bags; backpacks; duffle bags.

Class 35: Promoting goods and services in the sports, motorsports, electronic sports, and music industries through the distribution of printed, audio and visual promotional materials; promoting sports and music events and competitions for others.

Class 41: Entertainment; sporting and cultural activities.

("the 983 mark")

UKTM no. 3758365

MONSTER ENERGY

Filed on 23 February 2022 and registered on 12 August 2022

Class 9: Downloadable software namely virtual goods; downloadable software namely virtual goods in the field of beverages, food, supplements, sports, gaming, music, and apparel; Downloadable software namely virtual goods in the field of beverages, food, supplements, sports, gaming, music, and apparel for use in virtual environments and worlds; downloadable software namely virtual goods in the nature of beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewelry, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items; downloadable computer programs in relation to virtual goods, namely, beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewelry, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items; downloadable multimedia file containing artwork, text, audio, and video; downloadable multimedia file containing artwork, text, audio, and video

relating to beverages, food, supplements, sports, gaming, music, and apparel authenticated by non-fungible tokens; non-fungible tokens; blockchain tokens; downloadable computer software for managing, displaying, monetizing, buying, selling, trading, transferring, clearing, confirming, and authenticating virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets; downloadable computer software for use as a digital token wallet; cryptocurrency hardware wallets; downloadable software for enabling users to electronically create, store, send, receive, accept, exchange, and transmit digital assets; downloadable computer programs for data storage; downloadable computer programs for blockchain data storage; downloadable computer software for facilitating transactions with others; downloadable computer software for facilitating blockchain-based financial transactions; downloadable computer programs for data authentication; downloadable computer programs for data authentication via blockchain; downloadable computer software featuring the purchase and sale of rights to digital goods; downloadable computer software for managing digital collectibles; downloadable digital files; software; downloadable digital file sharing software; downloadable computer software and downloadable mobile application software for viewing images, videos, and content relating to beverages, food, supplements, sports, gaming, music, and apparel.

Class 35: Retail store and online retail store services featuring virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets; retail store and online retail store services featuring virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets in the field of beverages, food, supplements, sports, gaming, music, and apparel; retail store and online retail store services featuring virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets as part of a computer program; retail store and online retail store services featuring virtual goods, namely, beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewelry, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items; provision of an online

marketplace for buyers and sellers of artwork, text, audio, and video relating to beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewelry, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items authenticated by non-fungible tokens (NFTs); provision of an online marketplace for buyers and sellers of virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets; advertising, marketing, and promotional services.

Class 41: Entertainment services; entertainment services, namely, providing virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets; Entertainment services, namely, providing on-line, non-downloadable virtual beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewelry, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items; ; entertainment services, namely, providing an on-line virtual environment for using, trading, and purchasing virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets; providing online non-downloadable software for entertainment purposes; providing online non-downloadable software for entertainment purposes, namely, for shopping.

("the 365 Mark")

UKTM no. 3290275

#MonsterGaming

Filed on 15 February 2018 and registered on 13 July 2018 claiming a priority date of 16 August 2017.

Class 35: Services for advertising and promotion, including the promotion through downloadable websites; advertising and promotional services relating to the sale of goods and the sale of goods online; providing commercial information about electronic video games, their terms and about the sales/commercial conditions for obtaining incentives; administration of consumer loyalty programs; on-line advertising on a computer network.

Class 41: Entertainment services, including organizing sports, action sports, e-sports (video games), motor sports and motocross events; Entertainment information relating to news, videos, opinions, commentary, and images in the field of athletes, sports, e-sports (video games) and sporting events provided via a website; Publication of on-line journals and blogs in the field of athletes, sports, e-sports (video games) and sporting events; video production services; production of videos featuring music.

("the 275 mark")

UKTM no. 3414182



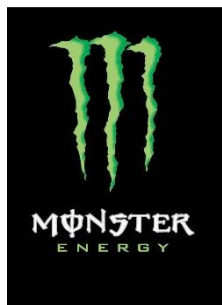
Filed on 16 July 2019 and registered on 8 November 2019 claiming a priority date of 16 January 2019.

Class 41: Entertainment services, namely, providing online video games and providing temporary use of non-downloadable video games, computer games, electronic games, and interactive games; arranging contests featuring online gaming; provision of online gaming operation, and coordination of game tournaments, leagues, and tours for recreational computer game playing purposes for customers to participate in via a website and on-line portal; entertainment services, namely, provision of online gaming via a website; provision of information

about online gaming and online gaming professionals via a website; entertainment services in the nature of sporting events, performances and competitions, electronic sporting events and competitions, and music performances and events; provision of entertainment information and news on athletes via a website.

("the 182 mark")

UKTM no. 3350876



Filed on 5 November 2018 and registered on 1 March 2019 claiming a priority date of 8 May 2018.

Class 9: Sport helmets; video recordings featuring sports, extreme sports and motor sports.

Class 18: All-purpose sport bags; all-purpose carrying bags; backpacks; duffel bags.

("the 876 mark")

4. Under section 5(3) the Opponent relies upon its 983 mark as aforementioned (as well as those marks listed below) claiming a reputation for *energy drinks, sports drinks, fruit juice drinks, other non-alcoholic beverages* in class 32. The Opponent claims that use of the contested mark is likely to mislead and/or confuse the consumer into believing that the respective marks are connected or in some way associated. The Opponent claims that use of the contested mark would without due cause, take unfair advantage of and/or be detrimental to the repute and/or the distinctive character of the earlier marks.

UKTM no. 3254991

MONSTER ENERGY

Filed on the 6 September 2017 and registered on 2 February 2018.

Relying on the following goods:

Class 32: Energy drinks, sports drinks, fruit juice drinks, other non-alcoholic beverages.

("the 991 mark")

UKTM no. 3315924

MØNSTER

Filed on the 6 June 2018 and registered on 31 August 2018.

Relying on the following goods:

Class 32: Non alcoholic beverages, including carbonated drinks and energy drinks.

("the 924 mark")

UKTM no. 917940339



Filed on the 7 August 2018 and registered on 15 May 2019.

Relying on the following goods:

Class 32: Non alcoholic beverages, including carbonated drinks and energy drinks.

("the 339 mark")

UKTM no. 3431545



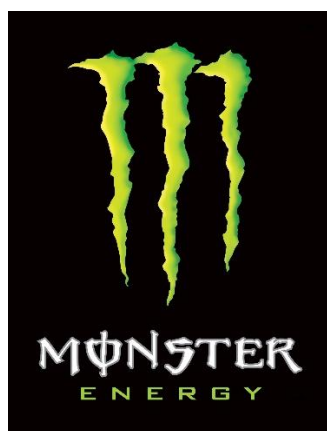
Filed on the 25 September 2019 and registered on 13 December 2019.

Relying on the following goods:

Class 32: Non alcoholic beverages, including carbonated drinks and energy drinks.

("the 545 mark")

UKTM no. 911154739



Filed on the 31 August 2012 and registered on 9 January 2013

Relying on the following goods:

Class 32: Non alcoholic beverages.

("the 739 mark")

5. In particular, under section 5(3) the Opponent claims that:

- The Opponent's marks enjoy substantial public recognition such that when faced with the Holder's goods its marks would be called to mind. This would cause an unfair advantage in that the Holder would gain unreserved exposure merely on the basis that the marks are highly similar.
- As a result of the high degree of reputation enjoyed by the Opponent's goods, use of the IR would cause detriment to the reputation of the earlier marks by way of tarnishing or degradation. In particular the Opponent will not be able to control the manner in which the Holder uses its mark, which may be in a manner which is adverse to the reputation of the earlier marks.
- As a result of the high degree of similarity between the respective marks a link will be formed in the mind of the public such that the distinctiveness of the earlier marks will be eroded. This will affect the economic behaviour of the relevant public reducing their ability to distinguish the goods being offered under the earlier marks from those of other traders. This will result in loss of sales.

6. Under section 5(4)(a), the Opponent claims to have used the signs set out below throughout the UK since 2008 for *drinks*, enjoying an extensive goodwill. It is contended that use by the Holder for the applied for goods will mislead the public into believing that such goods are provided, endorsed or otherwise commercially linked to the Opponent. This confusion will lead to considerable damage to the goodwill associated with the Opponent's signs. Consequently, use of the contested mark would be contrary to the law of passing off.

7. For the purposes of its 5(4)(a) claim the Opponent relies upon the following signs:

(i) MONSTER ("first sign")

(ii) MONSTER ENERGY (“second sign”)

(iii)

MØNSTER (“third sign”)

(iv)

MØNSTER
ENERGY (“fourth sign”)

(v)


MØNSTER
ENERGY (“fifth sign”)

(vi)


MØNSTER
ENERGY (“sixth sign”)

8. The Holder filed a defence and counterstatement denying the grounds of opposition and putting the Opponent to strict proof of its claims, particularly in relation to the goodwill and reputation it is said to hold in its various marks for the goods/services identified.

Proof of use

9. Due to their earlier filing dates, the marks upon which the Opponent relies qualify as earlier marks within the meaning of section 6 of the Act. The registration process of all the marks upon which the Opponent relies, save for the 739 mark, were completed less than five years before the filing date of the IR and therefore are not subject to the proof of use provisions as set out in section 6A. The Opponent may rely upon these registrations, therefore, without having to show what use it has made of them. In so far as the 739 mark, however, the Opponent made a statement of use and the Holder has put the Opponent to proof of the same.

Representation

10. The Opponent is represented by Bird and Bird LLP, and the Holder is represented by Lincoln IP. Only the Opponent filed evidence during the evidence rounds. A hearing was requested which was held on 6 March 2025 via video conference. Mr Andrew Norris K.C. (counsel), instructed by Bird and Bird LLP, appeared for the Opponent and Mr Stephen Walker from Lincoln IP appeared for the Holder. Both parties filed skeleton arguments prior to the hearing and relied upon various authorities, which I have considered fully in reaching my decision.

Evidence

11. The Opponent's evidence in chief consists of the witness statement of Paul J Dechary dated 18 October 2023 accompanied by 44 exhibits marked PJD1 to PJD44. Mr Dechary is the Executive Vice President and Deputy General Counsel of the Opponent which is a subsidiary of the Monster Beverage Corporation. Mr Dechary's evidence goes to the use the Opponent has made of its 739 mark and the reputation and goodwill it claims to hold for the aforementioned goods and earlier marks/signs as identified.

12. Whilst I have considered all the evidence, submissions and authorities in reaching my decision, I shall not summarise them in full but rather shall refer to the salient points to the extent that they are relevant at the appropriate stages of my decision.

Relevance of EU Law

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Decision

Section 5(2)(b)

14. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

15. Section 5A of the Act reads as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

The principles

16. The standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25 and are as follows:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may

retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

My Approach

17. Only the 739 mark is subject to proof of use. However, this registration is relied upon solely for the purposes of section 5(3), and the remaining marks are not subject to such a requirement. I will therefore put aside assessing the evidence and whether use has been shown for this registration unless and until it becomes necessary to do so. Further given the number of marks being relied upon, and the scope and breadth of their respective specifications, Mr Norris advanced the Opponent's case at the hearing primarily by reference to the 983 and 365 marks, accepting that these represented the Opponent's strongest case. I shall therefore adopt the same approach initially, only going on to consider the remaining earlier marks if it becomes necessary to do so.

Comparison of the goods/services

18. When conducting a goods/services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union ("CJEU") in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*, Case C-39/97, where the court stated at paragraph 23 that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be

taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

19. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat* [1996] R.P.C. 281, namely:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20. In so far as construing words in specifications, Lord Kitchin set out the proper approach to considering terms in specifications in *SkyKick UK Ltd & Anor v Sky Ltd & Ors*²:

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with

² (Rev1) [2024] UKSC 36.

first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

21. Further, in *YouView TV Ltd v Total Ltd*,³ Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

³ [2012] EWHC 3158 (Ch),

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

24. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he was then) noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

25. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

26. I also note section 60A of the Act which states:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

27. In any assessment regarding a comparison of the goods and services at issue it is incumbent on parties to identify with precision both in its pleaded case and in its submissions which goods/services of its own registrations are similar to which opposing goods/services, particularly where a number of earlier marks are relied upon and a broad range of goods/services. As stated by Mr Ian Purvis in *Smartx*; “*it is for the Opponent to put forward the combinations of goods on which it relies for similarity. If it fails to identify a particular combination it cannot expect the Hearing Officer to do the job for it.*”⁴

28. Given that in his skeleton, Mr Norris focussed the comparison on the Opponent’s class 9 and 18 goods of the 983 and 365 earlier marks, I shall begin my assessment against these classes within the specifications of these marks first. Further, the terms I have identified below appear to be the closest comparators and most relevant.⁵ As the specification of the 876 mark also includes one of these terms, I will also factor that mark into my assessment. I will consider the Opponent’s remaining specifications if it becomes necessary to do so. Whilst I have taken into account both parties’ respective submissions when undertaking the comparison, I do not propose to repeat them here in any detail.

29. The competing goods are, therefore, as follows:⁶

The Holder’s goods	The Opponent’s goods
Class 9: Computers, notebook computers, laptop computers, tablet	<u>983 mark</u> Class 9: Protective covers and cases for cell phones; Protective ear coverings,

⁴ At 28 *Smartx TM*, BL O/0911/24.

⁵ As per *Smartx TM*.

⁶ To the extent that they are relevant.

computers, computer mouses, mouse pads [computer peripheral], laptop carrying cases, sleeves for laptops, notebook computer carrying cases, cases adapted for notebook computers.	namely helmets; eye glasses, eye glass cases, sunglasses, sunglass cases.
	Class 18: All-purpose sport bags; all-purpose carrying bags; backpacks; duffle bags.
	<u>365 mark</u> Class 9: Software; downloadable software namely virtual goods in the nature ofbags....video game equipment and accessories....and other retail items; downloadable computer programs in relation to virtual goods, namelybags.....video game equipment and accessories.....and other retail items.
	<u>876 mark</u> Class 18: All-purpose sport bags; all-purpose carrying bags; backpacks; duffel bags.

30. I shall go through the Holder's terms in turn, grouping terms together where appropriate.⁷

Computers, notebook computers, laptop computers, tablet computers

31. The Holder's goods are a variety of hardware and physical devices to include desktop and mobile/portable computers. The Opponent has amongst other terms the term *software* at large within the specification of its 365 mark. The term software is a

⁷ Separode Trade Mark BL O/399/10

broad term encompassing a number of uses and applications and essentially provides a computer with a set of instructions in which to work. Whilst the Holder's goods are the physical devices, the Opponent's software enables the computers to perform a specific set of tasks. The respective goods differ in nature, method of use and purpose, but in my view they overlap in producer, trade channels and target the same end user. I also consider that the software and the hardware are complementary since the hardware is unable to function without the software and is therefore indispensable or important for the use of the other, as described in *Boston Scientific*. Taking these factors into account, I consider that the respective goods are similar to a medium degree.

32. Comparing these applied for terms against the 983 mark's goods, the Opponent relies upon amongst other goods *protective covers and cases for cell phones* in class 9 and *all-purpose carrying bags* in class 18 submitting that there is a complementary relationship between the respective goods because "a case for a cell phone is also a case for a small electrical computerised device and an all-purpose carrying bag is intended to be a carrying bag for all purposes". It was contended that as "laptops tablets and notebook computers are designed and intended to be portable... [they] are typically carried in a bag or case" making the carrying of these goods more convenient and "not carrying them in a bag exposes them to a risk of theft and damage".⁸ The Opponent argues that there is a high degree of similarity between these respective goods due to the close connection between them, where one is indispensable or important for the use of the other in such a way that customers would think that the responsibility for those goods lies with the same undertaking.

33. Dealing with the comparison against the Opponent's *protective covers and cases for cell phones* first, I begin by noting that the Holder's specification includes the term *computers* which I accept is a broad term that could encompass devices such as mobile smart phones, being in effect, small portable computer devices. However, taking the ordinary and core meaning of the goods, the average consumer would not class or refer to a cell phone as a computer (or for that matter a laptop, tablet or notebook) or vice versa, despite the fact that some of their functionality may overlap. Consequently, I do not find that the Holder's aforementioned goods are similar to the

⁸ Paragraphs 10 and 11 of the Opponent's skeletons.

Opponent's protective covers and cases which are specifically designed for 'cell phones'. They will not overlap in purpose, method of use, nature or producer. I also do not find that there would be complementarity or that the goods would be in competition with each other. Whilst there may be an overlap in user and trade channels on a high level of generality, this is insufficient for a finding of similarity on this basis alone. These respective goods are dissimilar.

34. Similarly, in so far as the Opponent's *all-purpose carrying bags* these goods fall within class 18. The bags and covers which are proper to class 9 are ones that are specifically adapted for the goods of that class, whereas the Opponent's *all-purpose carrying bags* being a bag for all purposes, are ones which denote use for a wide range of items.

35. In my view the nature, purpose and method of use of the applied for goods differ to the Opponent's *all-purpose carrying bags* other than, as before, on a very general level in so far as users and channels of trade. The Opponent's all-purpose goods being general use bags means that they are unlikely to coincide in the producer or retailer of computers. Whilst I accept that laptop bags and cases are likely to be sold alongside laptops and perhaps even produced by the same entity, it is far less likely that the same applies for general purpose bags that are not specifically adapted for such goods. Therefore, whilst it is foreseeable for a producer manufacturing portable computers to also provide/sell the protective covers, cases and bags used to protect and transport them, it is less likely for the manufacturer of an *all-purpose bag* that are not specially adapted to do the same.

36. In terms of being complementary, whilst it is desirable to have these portable goods transported in some sort of bag, I do not agree that the respective goods are "indispensable or important" for the use of the other, in terms of the caselaw. As Ms Emma Himsworth stated sitting as the Appointed Person in *Everest Dairies Limited v Everest Food Products Private Limited*:⁹

"The question of whether goods are 'complementary' is to be distinguished from use in combination, where goods are merely used together, whether for choice or convenience."

⁹ [O/0107/23] at 23(3)

37. Notwithstanding that a consumer may well choose to use a more general-purpose bag to carry the Holder's goods which carries out the same overall function as one specifically designed or adapted for the same purpose, it is unlikely that they would think that the same entities are responsible for the respective goods. I find that they are dissimilar.

38. Since the Opponent's 876 mark also includes the term *all-purpose carrying bags* the same findings apply to this mark.

laptop carrying cases, sleeves for laptops, notebook computer carrying cases, cases adapted for notebook computers.

39. The Holder's goods can be categorised as bags, sleeves and cases used to protect the computer hardware devices. I consider that they share similarity with the Opponent's *protective covers and cases for cell phones* and *all-purpose carrying bags* in its 983 mark. The goods overlap in overall purpose, methods of use and nature in that they are all goods in which objects are placed and are used to protect and transport the contents. They also overlap in trade channels and will be directed at the same end user. It is common for the goods at issue to be offered for sale in the same outlets as general purpose bags and protective cases. Given the overlapping purpose there is likely to be competition between them. Consequently, I consider that the respective goods are highly similar.

40. Since the Opponent's 876 mark also includes *all-purpose carrying bags*, the same findings apply for this mark.

computer mouses, mouse pads [computer peripheral]

41. In the same way that computers and protective cases/bags were argued to be complementary to each other, Mr Norris submitted that a "laptop tablet and notebook computer are designed and intended to be portable. A computer mouse goes where the computer goes and is also portable." Consequently, since computers are carried in bags and are similar, Mr Norris argued it stands to reason that the same would apply to computer mouses and pads on a complementary basis.

42. The Holder's goods are accessories or ancillary devices which attach externally to a computer or mobile device or something that is used in connection with a computer. These goods are one step removed from the Holder's computers and one step

removed still from what can broadly be categorised as the Opponent's protective covers, cases and all-purpose bags. I do not consider that there is any obvious similarity between the respective goods as argued by the Opponent. They differ in nature, purpose and methods of use. They are not in competition nor are they complementary. In so far as users and channels of trade, whilst there may be a degree of overlap this would be on a very high level of generality but insufficient for there to be a finding of similarity on this basis alone. Despite the fact that computer mice and mouse pads are in the general field of computer technology and are small items which can be transportable, this does not make them similar to the Opponent's bags and protective covers as claimed. Consequently, I find the respective goods are dissimilar.

43. For the same reasons I do not find that these goods are similar to the Opponent's term *software* of its 365 mark.

44. Comparing these goods against the Opponent's other terms identified by Mr Norris namely "*downloadable software namely virtual goods in the nature ofvideo game equipment and accessories....and other retail items; downloadable computer programs in relation to virtual goods, namely video game equipment and accessoriesand other retail items*" he submitted that there is a connection between real and virtual goods such that the average consumer would perceive virtual and real world goods in the same way. He referred me to the GC's decision in *Glashutter v EUIPO*¹⁰ asking me to follow the same approach. However, in that decision, the GC found that it was necessary to take account of the particular nature of the virtual goods (and services) in question when undertaking the assessment of similarity, which in that case related to physical and virtual watches. I do not consider that this decision assists the Opponent given the nature of the goods at issue. In my view the average consumer would not map physical computer mice, mouse pads and peripherals into the virtual world and consider them to be similar to the Opponent's *downloadable software namely virtual goods in the nature ofvideo game equipment and accessories* in the way submitted Mr Norris. The respective goods differ in nature, purpose, method of use, are neither complementary nor in competition. Whilst they

¹⁰ T-1163/23

may overlap in user this would be on a high level of generality and insufficient for a finding of similarity on this basis alone. I find that they are dissimilar.

45. At the hearing, Mr Norris expanded his submissions from those outlined in his skeleton and addressed me on the similarity between the Holder's goods and the Opponent's entertainment services and retail services in classes 35 and 41. For completeness, I shall, therefore, consider these additional comparators.

46. Firstly, I note that some of the Opponent's terms in class 35 include the words 'namely' and the like, which have a limiting effect to the terms that follow. Therefore, given that these class 35 services relate to virtual goods and I did not find similarity between the physical goods and the virtual goods, the Opponent is in no better position relying on services related to the same, than in my earlier findings. I dismiss the Opponent's arguments in this regard. The applied for goods and registered services are dissimilar.

47. Secondly, the Opponent relies upon entertainment services at large as well as subcategories of the same. I will therefore consider the Holder's goods against the Opponent's broader term. If I do not find similarity in relation to entertainment services at large, then the Opponent will not be any closer in relation to the subcategories.

48. Computers are tangible/digital products with a technical function, and the mouses and mouse pads are ancillary devices, whereas entertainment services are activities aimed at amusement and leisure. I see no obvious similarity between the respective goods and services. They differ in nature, purpose, method of use, channels of trade and end user. The fact that a computer and the peripherals may be used to play a computer game and to access or facilitate the entertainment services is insufficient for similarity to be found on the basis of complementarity, in accordance with settled caselaw. The applied for goods and the class 41 services are dissimilar.

49. Further, having considered the Opponent's remaining goods and services of the other earlier marks relied upon, I see no obvious similarity between the Holder's goods beyond those that I have already identified above. Consequently, the opposition under section 5(2)(b) fails, in respect of those applied for goods that I found to be dissimilar, and in so far as the opposition under section 5(2)(b) is based upon those remaining

earlier marks. In absence of similarity between the respective goods and services there can be no likelihood of confusion.¹¹

50. Given these findings, the opposition based on section 5(2)(b) shall proceed only in respect of the Opponent's earlier marks and goods, as set out below, for which I shall undertake the likelihood of confusion assessment.

The 983 mark

Class 9: Protective covers and cases for cell phones.

Class 18: all-purpose carrying bags.

The 876 mark

Class 18: all-purpose carrying bags.

The 365 mark

Class 9: software.

Average Consumer and the purchasing process

51. When considering the opposing marks, the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods in question.¹²

52. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

¹¹ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

¹² *Lloyd Schuhfabrik Meyer*, case c-342/97.

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

53. The average consumer will include members of the general public generally or those who have an interest in computer-based gadgetry and technology, as well as specialist business purchasers requiring, for example, specific hardware or programmes to run their businesses. The purchasing process is likely to be primarily visual with consumers purchasing the goods from retail premises or their online equivalents through websites and internet search engines. I do not ignore the fact that an aural process may factor through recommendations or as a result of requests made to sales assistants.

54. I consider that the respective goods cover a broad range of computer equipment, from computer devices to the software used to operate them and cases and bags used to protect and transport them. These goods are typically purchased for their durability

and are therefore unlikely to be frequent, daily purchases. For the computers and software goods, taking into account the technological nature of the goods on offer, for either category of consumer, the level of attention will be slightly higher than average (medium), but not considerably so, as normal considerations such as price, reputation, quality and suitability would apply. For the bags and cases, I consider that the level of attention undertaken would be lower to between a low and medium degree, albeit with similar considerations in play, such as price, suitability and quality.

Comparison of the marks

55. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

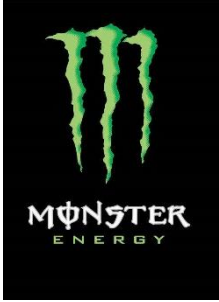
“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

56. It would be wrong to artificially dissect the trade marks, although, it is necessary to consider the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

57. In light of my findings in relation to the comparison of the goods, the respective trade marks are shown below:¹³

The Holder's mark	The earlier marks
	<u>The 983 mark</u>

¹³ In terms of the Opponent's marks for which I have found similarity between the respective goods.

PERFORMONSTER	MONSTER <u>The 365 mark</u> MONSTER ENERGY <u>The 876 mark</u> 
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Overall impression

58. The Holder's mark consists of the invented word PERFORMONSTER presented in a slightly stylised emboldened font. It has been accepted by the parties that the mark is a portmanteau word made up of the two words PERFORM and MONSTER. I consider that the overall impression of the mark resides in the totality of the word with the font and stylisation playing lesser roles.

59. The Opponent's 983 mark is for the single word MONSTER with no other elements to contribute. The overall impression, therefore, resides in the entirety of the word.

60. The 365 mark consists of the two words MONSTER and ENERGY. The overall impression is in the combination of these two words.

61. The 876 mark consists of a number of elements; the same words MONSTER and ENERGY in a highly stylised coloured font. The word MONSTER is presented in white and the word ENERGY is presented underneath in green, in considerably smaller font. Above the words, is a large green device depicting a claw mark. All these elements are displayed on a black rectangle, which has little trade mark significance as it will merely be regarded as a background upon which the other elements are presented. Due to its size and position within the mark, the claw device creates the greatest impact, however, the words are the elements that can be read and consequently they

also draw the eye. Therefore, balancing the impact of the device against the words, I consider that on the whole the word MONSTER and the claw device play roughly equal roles in the overall impression of the mark, with the word ENERGY playing a slightly lesser role due to the smaller font, in comparison with the other elements. The colour combination and stylisation whilst contributing, playing lesser roles overall.

Visual comparison

The IR as against the 983 mark

62. Visually, the marks coincide to the extent that the entirety of the 983 mark appears at the end of the IR. The letters PERFOR- at the beginning of the IR create a point of visual difference. Given that beginning of marks tend to have more aural and visual impact, greater emphasis will be made on the prefix PERFOR-M.¹⁴ The stylisation will also be a point of visual difference but not significantly so since the Opponent's mark is a word only mark and therefore notional and fair use means that it can be used in any font. Consequently, weighing up the similarities as against the differences, particularly with the common element being contained within and at the end of the IR, I consider that the marks are similar to between a low and medium degree.

The IR as against the 365 mark

63. The visual similarity between the contested mark and the 365 mark is further away than my findings above, due to the addition of the word ENERGY which has no counterpart in the IR. Consequently, given the positions of the respective words within the marks, I consider that the respective marks are visually similar to a low degree.

The IR as against the 876 mark

64. Given the number of elements present in the 876 mark to include the device, colour combination and particular stylisation of the words MONSTER and ENERGY, I consider that the visual similarities are even further away. Consequently, these marks are visually similar to a very low degree.

¹⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Aural comparison

The IR as against the 983 mark

65. The word MONSTER of the earlier 983 mark will be given its ordinary English dictionary pronunciation. The IR will be pronounced as PURR-FORM_MON-STER (with the middle letter M at the end of second syllable rolling into the pronunciation of the letter M at beginning of the third syllable). I disagree with the Opponent that greater aural emphasis will be placed on the word/letters M-ONSTER as opposed to the word PERFOR-M and consider that equal emphasis will be given to each element when pronounced. The word MONSTER at the end of the Holder's IR will nevertheless still be decipherable and pronounced identically with the entirety of the 983 mark, despite its position and the shared letter M. The articulation of the first element (essentially, sounding like the word PERFORM) acts as a point of aural difference. Given that the common element is at the end of the word it will have less aural impact. Consequently, I consider the marks to be aurally similar to between a low and medium degree.

The IR as against the 365 mark

66. In so far as the comparison between MONSTER ENERGY and PERFORMONSTER, all elements of the respective marks will be articulated and the pronunciation will be the same as for the 983 mark save for the additional word ENERGY in the 365 mark which will be pronounced in the normal way. Weighing up the similarities as against the differences, I consider that the respective marks will be aurally similar to a low degree.

The IR as against the 876 mark

67. The device and the stylisation in the 876 mark will not be articulated and therefore it will be pronounced in the same way as the 365 mark with the same finding of a low degree of aural similarity.

Conceptual comparison

68. All of the earlier marks include the word MONSTER which will either be perceived as a reference to a mythical beast or depending on the context in which it is used someone or something that is extremely large (although the latter meaning would normally only be the case if it was followed by a word that gave it that meaning, for

example MONSTER TRUCK). The concept of the word MONSTER will therefore be shared across all marks. The distinctions lie with the inclusion of the concept of the word PERFORM (which will be readily identified, notwithstanding the shared letter M) in the IR, the word ENERGY in the 365 and 876 marks and the additional device in the 876 mark.

69. As an invented word, the meaning of the IR as a whole is not entirely clear. However, even invented words are capable of being evocative or suggestive of a concept, if elements of the mark resemble known words.¹⁵ Both parties accept that the IR is a portmanteau of the words PERFORM and MONSTER, therefore, consumers will extract and recognise the word MONSTER at the end of the word. Given the technological nature of some of the Opponent's goods I agree with the parties that the suffix PERFORM will in this context allude to performance "implying high performance of the relevant goods"¹⁶ or "that they are performance versions i.e. better or higher specification versions".¹⁷ Consequently, the 983 mark and the IR are conceptually similar overall to a medium degree.

70. In so far as the 365 mark, the word ENERGY introduces an additional conceptual distinction. But given that both marks may be perceived as referring to the word MONSTER the respective marks are still conceptually similar but, overall, to between a low and medium degree.

71. The addition of the claw device to the words MONSTER and ENERGY in the 876 mark merely reinforces the meaning of a mythical beast rather than any other meaning and therefore the conceptual similarity between the IR and this earlier mark will be no different to that which I found with the 365 mark, namely to between a low and medium degree.

Distinctive character

72. Registered trade marks possess varying degrees of inherent distinctive character. Those marks that are regarded as descriptive of the goods will possess a low degree of distinctiveness. Conversely invented words with no association to the goods are

¹⁵ *Usnor SA v OHIM* T-189/05

¹⁶ Holder's skeletons para 12.

¹⁷ Opponent's skeletons para 24.

highly distinctive. The more distinctive the earlier marks (either per se or by the use that has been made of them) the greater the likelihood of confusion.¹⁸

73. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

74. Dealing with the inherent position first. Mr Norris argued that the word MONSTER solus in the 983 mark was unique and highly unusual and therefore the inherent distinctive character would be high. I do not agree. Whilst I accept that the word MONSTER does not allude to or describe the goods at issue it is nevertheless an ordinary English dictionary word. Consequently, in my view it is inherently distinctive to an average (medium) degree.

75. In so far as the 365 mark, namely MONSTER ENERGY again neither word is directly descriptive or allusive of the relevant goods. I consider that, as a whole, it is inherently distinctive to a medium degree.

76. The addition of the claw device in the 876 mark adds to the distinctiveness of the mark but merely reinforces the idea of a mythical beast. In combination with the words, the mark as a whole is inherently distinctive to a medium degree.

77. The Opponent has pleaded a reputation and an enhanced degree of distinctive character but only in relation to *energy drinks, sports drinks, fruit juice drinks, other non-alcoholic beverages* in class 32. Whilst I note that it filed evidence from Mr Dechary which appears to include sponsorship of online/gaming events, there is no

¹⁸ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch).

indication that its reputation which would apply equally to its enhanced distinctive character extends to any of the goods it relies upon in classes 9 and 18 to be material to the assessment. The evidence does not demonstrate or support the claim that it has enhanced the distinctive character of its marks for computer software or bags/protective coverings. Any reputation and enhanced distinctive character it may hold in its class 32 goods, are not relevant to the assessment for the goods at issue.

Likelihood of confusion

78. When considering whether there is a likelihood of confusion between the marks, I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods originate from the same or a related source.

79. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind. Mr James Mellor, as the Appointed Person, directed that a common sense approach should be undertaken in any assessment, stating “every comparison must be conducted according to the approach laid down in the CJEU case law and every comparison will depend on its own facts” applying “the well-established propositions for assessing the visual, aural and conceptual similarities.”¹⁹

80. The difference between the two types of confusion was described in the following terms by Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*:²⁰

¹⁹ *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20.

²⁰ BL O/375/10.

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

81. I bear in mind that the examples as set out by Mr Purvis in *L.A. Sugar* (above) are not exhaustive and that they are only intended to be illustrative of the general

approach.²¹ Furthermore, in *Liverpool Gin*, Arnold L.J. pointed out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. A finding of indirect confusion should not be made merely because two marks share a common element; it is not enough that one mark merely calls to mind another, this is mere association, not indirect confusion.²²

82. Earlier in my decision I found that:

- the IR and the 983 mark were visually and aurally similar to between a low and medium degree and conceptually similar to a medium degree.
- the IR and the 365 mark were visually and aurally similar to a low degree and conceptually similar to between a low and medium degree.
- the IR and the 876 mark, were visually similar to a very low degree, aurally similar to a low degree and conceptually similar to between a low and medium degree.
- the Opponent’s *protective covers and cases for cell phones* and *all-purpose carrying bags* (the 983 and 876 marks) were similar to a high degree to the applied for *laptop carrying cases, sleeves for laptops, notebook computer carrying cases, cases adapted for notebook computers* but dissimilar to the applied for *computers, notebook computers, laptop computers, tablet computers*. I found these latter applied for goods were similar to a medium degree to the Opponent’s *software* (the 365 mark).
- the average consumer was a member of the general public and a business user.
- the goods would be selected predominantly via visual means (but not discounting aural considerations). Consumers would pay between a low and medium degree of attention in relation to purchasing bags, sleeves, covers and cases and a slightly higher than average (medium) degree of attention for the computers and software goods.
- the earlier marks overall enjoyed a medium degree of inherent distinctive character. Whether the earlier marks enjoyed an enhanced degree of distinctive character for goods in class 32 goods would not make any difference to the

²¹ *Liverpool Gin Distillery Limited v Sazerac brands LLC* [2021] EWCA Civ 1207

²² *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

assessment for the goods at issue in classes 9 and 18. The evidence in any event did not support the claim that the earlier marks enjoyed an enhanced distinctive character for bags, covers and software goods.

The likelihood of confusion between the IR and the 983 mark

83. Dealing with the comparison as against the 983 mark first, I remind myself that the goods that I found to be similar were the Holder's *laptop carrying cases, sleeves for laptops, notebook computer carrying cases, cases adapted for notebook computers* as against the Opponent's '*all-purpose carrying bags*' and '*protective covers and cases for cell phones*'.

84. In terms of direct confusion, Mr Norris accepted that consumers would be unlikely to misremember or mistakenly recall the one mark for the other, given the additional elements in play between the respective marks and the position of the common element MONSTER in the IR. He did not advance a case of a likelihood of direct confusion, therefore. I agree. As a result of the visual differences between the marks for goods purchased predominantly by visual means, the respective marks will not be mistakenly recalled or misremembered for each other.

85. However, in so far as indirect confusion, Mr Norris submitted that due to the similarities between the marks and the goods, consumers would consider that there would be an economic connection between the two marks believing that the goods produced under the contested mark are "the performance versions" of the Opponent's goods.

86. Taking all of the global factors as identified into account, I find that in the context of the goods at issue the concept conveyed by the addition of the first element PERFOR-M to the common element M-ONSTER will be perceived as goods that offer an enhanced or increased performance as compared with the Opponent's more general purpose bags, covers and cases. Consumers are likely to perceive the addition of the element PERFOR-M to the word M-ONSTER as indicating a sub brand of the Opponent's mark, and that the Holder's goods are ones specifically adapted or designed to protect the contents from damage. Consumers are likely to view PERFORMONSTER, therefore, as denoting a performance enhanced range originating from the same or economically linked undertaking. Taking into account the interdependency principle and notwithstanding the position of the common element in

the IR, my finding that the goods are highly similar offsets the impact of the shared element being at the end of the contested mark. I find that there is a likelihood of indirect confusion.

The likelihood of confusion between the IR and the 365 mark

87. Whilst I consider that the respective goods that I found to be similar i.e. in general terms computers and software, are capable of being referred to in the context of performance versions, there is a greater distance between the marks themselves which are less similar as a result of the presence of the additional word ENERGY in the 365 mark. Consequently, I do not consider that the IR will be directly or indirectly confused with the 365 mark. For the Holder's computer devices and the Opponent's software, I found that the consumer will pay a slightly higher than average degree of attention in the selection process and so the differences that I outlined earlier in my decision would not be overlooked. Given the various additional components in play, I do not consider that the consumer would confuse the respective marks. In my view, when factoring in the additional word ENERGY in the 365 mark, which has not meaning in relation to the relevant goods, the IR is not consistent with a brand extension or sub brand of this earlier mark and the Opponent has not provided any explanation as to why this is likely to be the case. In my view, the average consumer would not consider the Holder's goods as being provided by the same or related undertaking as the Opponent or vice versa. There is no likelihood of indirect confusion.

The likelihood of confusion between the IR and the 876 mark

88. Similarly, the same finding applies in relation to the 876 mark. I do not find that consumers would directly or indirectly confuse the IR with the Opponent's earlier 876 mark. Here the mark is inherently distinctive overall to a medium degree, but this is as a result of the combination of the device and the words and not solely in the common element MONSTER. Notwithstanding the interdependency principle, the high degree of similarity between the goods does not offset the very low degree of visual similarity between the marks, for goods purchased predominantly visually. I find there to be no likelihood of indirect confusion.

89. Before concluding the section 5(2)(b) ground I shall briefly deal with the family of marks argument raised by Mr Norris for the first time at the hearing. He submitted that as a result of the configuration of the common element MONSTER within the various

earlier marks relied upon and additional ones referred to by Mr Dechary's in his witness statement this was an additional global factor to be taken into account and "one of the elements leading to a likelihood of confusion".

90. Firstly, I note that the family of marks argument was not pleaded. This, in itself, is sufficient reason to dismiss this line of argument. Secondly even if it had been, I do not accept the argument that the earlier rights relied upon or those referred to in evidence constitute a family of marks. To begin with in order to establish a family, the marks must share a distinctive common element that forms a recognisable pattern, enabling consumers to perceive them as coming from the same undertaking. It is not enough for a proprietor simply to own a number of similar-looking marks incorporating the same common element. To succeed a proprietor must show that they have marketed the marks in a way that educates consumers to see them as related and also to demonstrate that the relevant public actually perceives that the marks form part of a wider family deriving from a common root denoting commercial origin. The mere presence of a common element, configured in different ways does not automatically create a family of marks.

91. Based on the evidence and submissions before me, I do not consider that, even if it had been pleaded, the evidence is sufficient to show that the earlier marks constitute a family of marks. Mr Dechary's witness statement is heavily focussed on the use of the mark MONSTER ENERGY in its figurative form particularly in combination with the claw device. Whilst reference is made to use of other marks/signs, for example, MONSTER PUNCH, the evidence is limited and is insufficient to demonstrate that consumers in the UK have been educated to understand that these marks/signs are part of the same 'family'. Further, these additional marks/signs are not relied upon in any of the grounds of opposition. The family of marks argument therefore takes the Opponent no further.

Section 5(2)(b) Conclusion

92. Having considered all the global factors, I find that there is a likelihood of confusion but only as against the following applied for goods namely *laptop carrying cases, sleeves for laptops, notebook computer carrying cases, cases adapted for notebook computers*. The opposition under section 5(2)(b) succeeds as against these goods.

93. In relation to the other goods, for the reasons outlined above, I do not find that there is a likelihood confusion, and the opposition under section 5(2)(b) fails as against *computers, notebook computers, laptop computers, tablet computers, computer mouses, mouse pads [computer peripheral]*.

Section 5(3)

94. Section 5(3) of the Act states:

“A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

95. I bear in mind the relevant case law set out in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier marks are similar to the IR. Secondly, the Opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions are met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) for the goods to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. I note for the purposes of its 5(3) ground that the Opponent relied on those marks as set out at paragraph 4, accumulatively for goods in class 32

namely *energy drinks, sports drinks, fruit juice drinks, other non-alcoholic beverages*. For the purposes of section 5(3) the relevant date for the assessment is 11 April 2022.

Similarity between the marks

96. Given that the marks relied upon under section 5(3) are more or less mirror images of those that the Opponent relied upon under section 5(2)(b), in light of my earlier findings I find the marks to be similar overall visually, aurally and conceptually in varying degrees as a result of the shared common element MONSTER for the same reasons.²³ Consequently, this first condition is satisfied.

Reputation

97. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

98. In assessing whether the earlier marks have a reputation to a significant number of consumers, I must assess the evidence in terms of the extent it demonstrates “the

²³ The 991 mark is identical to the 365 mark and the 739 mark is identical to the 876 mark and therefore the same findings I made earlier would apply equally to these marks.

market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”²⁴

99. The Opponent claims a reputation in relation to *energy drinks, sports drinks, fruit juice drinks, other non-alcoholic beverages*. At the hearing Mr Walker on the Holder’s behalf conceded that the Opponent held a reputation in relation to the above terms but that its reputation was stronger in relation to some marks than others. Mr Norris agreed with this contention. Given this position I shall assess the evidence but have in mind that a protectable reputation has been shown.

100. Mr Dechary outlines the history of the brand having launched the ‘original MONSTER energy’ drink in the US in 2002 and in the UK in 2008, expanding into more than 140 countries worldwide.

101. Mr Dechary states that the Opponent has sold more than 48 billion cans worldwide since launch, generating over \$92 billion in retail revenue, with global sales around 6 billion cans per year. Sales are said to have increased every year since 2002. Photographs are produced (an example of which is reproduced below) depicting the MONSTER ENERGY mark as displayed on its canned drink on the UK market dated 28 April 2018:²⁵



102. In the UK it is said that between 2012 and 2022 the Opponent has sold over 2.6 billion cans in the UK with annual UK sales over the same period reaching over

²⁴ *General Motors* para 27

²⁵ Exhibit PJD1

EUR 1.9 billion. Its cans are said to be available across more than 50,000 retail stores and 7,600 pubs, and each can “bore one or more of the MONSTER marks” as relied upon. These UK retailers include Tesco, Co-op, Lidl and Sainsbury’s. I accept that these are all prominent UK retailers, with stores across the entirety of the UK. The brand is said to be the second-best-selling energy drink in the EU.

103. In support, Mr Dechary produced photographs of the cans bearing the various marks produced for the UK market as displayed in various retail outlets²⁶ as well as screenshots taken from UK specific websites and invoices to various distributors dated between 2018 and 2021.²⁷

104. Similar evidence is produced relating to the sales and distribution of its goods in various retail outlets throughout the EU to include Germany, Italy, France and Denmark.²⁸

105. Mr Dechary confirms that the Opponent holds a significant UK market share in energy drinks, as taken from Nielsen²⁹ data which were presented to investors.³⁰ It is said that its UK market share rose from 8.8% in 2012 to approximately 30% by 2022. Whilst not directly specifying in what goods the market share relates to, given the nature of the evidence and the claim to a reputation only being for those goods in class 32, particularly energy drinks (there being no evidence of any use for any other beverages at large), then I take the reference to market share as relating to the energy drinks industry.

106. It is said that the Opponent and the brand has enjoyed extensive industry recognition and awards.³¹

107. Mr Dechary states that its marketing and promotional strategy is unconventional in that it does not use direct television or radio advertising to promote its goods, rather in the UK, it engages in athlete and event sponsorships and product placement as a way of increasing its exposure to consumers. It is said to be known for its edgy and extreme advertising campaigns attracting its target consumer as well as promotion

²⁶ Paragraph 23.

²⁷ Exhibits PJD2 and PJD3.

²⁸ Exhibits PJD4 to PJD14.

²⁹ A global market measurement and data provider.

³⁰ Exhibit PJD15.

³¹ Exhibit PJD16.

through MONSTER branded apparel and merchandise.³² It is said to have invested more than \$11.2 billion globally in advertising, promoting and marketing its MONSTER energy drinks since 2002. Particularly in relation to the UK, it has spent in excess of \$826 million between 2011–2021, and \$123 million on sales and marketing activities in 2022 alone. It is said that its advertisements and promotions for its MONSTER energy drinks feature “at least one of its MONSTER marks” but these are not broken down further by individual mark.³³

108. In so far as its online and social media presence it is said to be significant with over 2.2 million visits to its website www.monsterenergy.com from UK individuals. It has 25 million Facebook likes (of which 1 million are from the UK), 8.5 million followers worldwide on its Instagram platform. It has various YouTube channels which generate more than 1.2 billion views worldwide. Its Monster Energy channel, in particular, is said to have had 19.8 million views from individuals residing in the UK since 2006.³⁴

109. Mr Dechary also outlines the extensive sponsorship the Opponent has undertaken of over 211 professional athletes for example Lewis Hamilton, Valentino Rossi, Conor McGregor, Tiger Woods and teams to include those in the motor car racing fields (to include Formula One, MotoGP, Supercross and major Rally events) and former UFC/MMA champions. It further sponsored and advertised at various sporting events to include the X Games, the English Premier League (football), British Superbikes Series, Isle of Man TT, various mountain bike events and major Rally/Motor GP events, garnering millions of online views and high profile appearances in the UK media to include BBC’s Top Gear TV series. Images are produced of these athletes wearing branded clothing which it is said ensure the Opponent’s marks’ continuous visibility. Nielsen and Hookit (brand awareness companies) are said to have named Monster as the 4th Most Marketed Brand in Sports.³⁵

110. The Opponent also sponsors “The Monster Army” team which is a global amateur athletes programme with more than 20,000 UK applicants. These participants all wear

³² Paragraph 59.

³³ Paragraph 62.

³⁴ Paragraph 73 and Exhibit PJD 19

³⁵ Paragraph 77 and Exhibit PJD 17

branded clothing and are assisted with their gear, training and travel expenses. It also sponsors major music festivals and musicians worldwide.

111. The marks appear in internationally popular video games (e.g. Need for Speed and the Skate Dirt series) and is promoted through its collaborations with major game publishers, which include releases of special edition cans promoting these collaborations when new games are released.³⁶

112. The Opponent licenses use of its 'Monster marks' on various special edition video game equipment. Examples are given for Sony Playstation and Xbox game controllers and a DXRacer gaming chair, however, no details are provided regarding the extent of these licensing agreements or the amount of sales generated in connection with the same. It also sponsors major E-Sports teams who compete globally with Monster branded equipment and clothing said to reach millions of viewers including substantial numbers from the UK. A list of competitions featuring MONSTER sponsored teams are produced.³⁷

113. The Opponent produces and distributes large volumes of Monster branded clothing (an image of which is reproduced below) and merchandise to include t-shirts, accessories and promotional items which are distributed or sold at events.³⁸ No financial details are provided regarding the extent of sales associated with such activities.



114. It is asserted by Mr Norris that the Opponent's "massive reputation extends far beyond that of an energy drink and that it is widely known for extensive promotional

³⁶ Paragraphs 181-182 and Exhibits PJD 41-42.

³⁷ Exhibit PJD 43.

³⁸ Exhibit PJD 44.

activities, including motorbike and car racing teams and events, sports personalities, and high-profile brands". I do not agree. Any involvement in sporting events or its sponsorship of sports personalities is merely ancillary to, and forms part of, the promotion of its core products. The evidence does not support the contention that the Monster has acquired a reputation beyond the goods it manufactures. I am not persuaded therefore that its reputation extends to other commercial fields as alleged.

115. Having reviewed the evidence, it shows that the Opponent has undertaken extensive sales and promotional activity in the UK, particularly in relation to the mark as set out below which has been referred to by Mr Dechary throughout his statement:



116. I am satisfied that the Opponent holds a very strong reputation for energy drinks under its figurative 739 mark which includes the claw device (as depicted above). The Opponent's evidence in relation to its global sales, market share and promotional activity however was not broken down by individual mark. Despite this I consider that the reputation it holds extends across all marks, although I accept to a lesser degree in relation to other marks which are not presented in the same particular style or absent the claw device as it uses in its 739 mark. Mr Walker in any event accepted at the hearing that the Opponent had a protectable reputation and goodwill across all its marks for *energy drinks, sports drinks, fruit juice drinks, other non-alcoholic beverages*. Consequently, I shall proceed on the basis that the Opponent has a very strong reputation for energy drinks across all earlier marks, but I shall focus my attention on its 983 mark, as being a word only mark, this represents the Opponent's best case.

Link

117. As I noted above, I must now go on to consider whether the Opponent's reputation would give rise to the necessary mental link being made between the respective trade marks. The factors to be taken into account to establish as to whether a link would be made, are those as set out in *Intel*.³⁹ Taking each of the factors in turn:

The degree of similarity between the conflicting marks

Earlier in my decision when considering the section 5(2)(b) ground I found the IR and the 983 mark to be similar visually, aurally and conceptually in varying degrees and I adopt those same findings here.

The nature of the goods for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services and the relevant section of the public.

Under section 5(2)(b) I found some of the applied for goods were not similar to the Opponent's goods of its 983 mark and others similar to a high degree. However, this finding was in relation to an assessment of the applied for goods as against the Opponent's goods in classes 9 and 18. In so far as the Opponent's goods in which it holds a very strong reputation namely *energy drinks* I find no obvious similarity between these goods and those of the Holder's which can broadly be described as computer devices and peripherals and protective covers for the same. The respective goods differ in nature, purpose, method of use and trade channels. They are not complimentary nor in competition with each other. The fact that they may overlap in end user is insufficient given that this would only be at a high level of generality. The goods are dissimilar. For the avoidance of doubt, the same finding would apply to all of the remaining goods it relied upon in class 32.

The average consumer is the same as before save that the Opponent's goods would only be directed at members of the general public.

The strength of the earlier marks' reputation

³⁹ *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU).

I shall proceed on the basis that the Opponent holds a very strong reputation for energy drinks.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

I shall proceed on the basis that the distinctive character of the 983 mark has been enhanced through use to a high degree in the UK in relation to energy drinks.

Whether there is a likelihood of confusion

I do not find that the Opponent's energy drinks share any similarity with the applied for goods. In my view, the respective goods are too distant for a likelihood of confusion to arise.

118. A link means that the earlier marks will be brought to mind by the applied for mark. Focussing on the 983 mark given the distance between the goods at issue and the degree of similarity between the marks, which at its height in so far as the visual and aural comparison I found did not go beyond between a low and medium degree, I do not find that a link would be made. The Opponent's reputation is held in energy drinks and I find no similarity between those and the Holder's goods in class 9. Whilst I accept that there is no necessity under this ground for the respective goods to be similar, there must, however, be a link made in the minds of the relevant public. I see no conceivable way in which the relevant public would find a link between an entity producing energy drinks and an entity producing computers, peripherals and protective covers, sleeves and cases for such goods. Whilst the respective entities share the word MONSTER this word is presented at the end of the contested mark subsumed within a much longer word and where the letter M at the end of the word PERFORM and at the beginning of the word MONSTER is merged.

119. Despite the very strong reputation held by the Opponent the marks are insufficiently close to be able to bridge the gap between the different fields of activity. Whilst I acknowledged that under section 5(2)(b) there was a likelihood of confusion between some of the goods of the Opponent's 983 mark, the goods to which this finding was directed were ones in classes 9 and 18, whereas here the goods are those

in class 32 as against class 9 goods. My primary finding is that the earlier mark would not be brought to mind, but if it were it would be fleeting at best and insufficient for the requisite link to be made in the minds of the consumer. A mere wondering whether there is a connection is not enough.

120. Given this finding, without a link, no damage can follow. The section 5(3) ground fails in its entirety on the basis that the Opponent's reputation is held in different goods to that which it relied upon under section 5(2)(b) and the distance between the respective marks and goods is too great to overcome.

121. I have made this finding based on the Opponent's 983 mark. In relation to the remaining earlier marks, it follows that the same conclusions would apply particularly given the increased distance between the remaining earlier marks and the IR. If no link is found between the IR and the word only MONSTER mark, a link is even more unlikely with marks that include additional words and figurative elements.

122. The section 5(3) ground fails in its entirety.

Section 5(4)(a)

123. Strictly speaking having found in favour of the Holder under section 5(3) and the Opponent having only been partially successful under section 5(2)(b), given that it relies upon effectively the same signs and for 'drinks', its section 5(4)(a) will not increase its level of success. For completeness, however, I shall deal with this ground all be it briefly.

124. Section 5(4)(a) of the Act states as follows:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ... A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

125. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

126. In order for the Opponent to succeed under this ground it must demonstrate goodwill, misrepresentation and damage. Since goodwill is territorial, the Opponent must establish that it had the requisite goodwill with UK consumers as at the relevant date of 11 April 2022. The Holder has not filed evidence nor claimed that it has used its IR prior to this date and therefore I have no other date to consider other than the prima facie relevant date.

Goodwill

127. Goodwill arises out of trading activities which must be considered in the context of revenue sales figures, promotional activity and customers in the UK. In light of the evidence filed as outlined earlier in my decision and the nature of the goods in question I have no hesitation in finding that the Opponent has a strong goodwill in relation to ‘energy drinks’.

Misrepresentation

128. In my view, there is insufficient connection between the respective goods for a substantial number of the Opponent’s customers or potential customers to be misled into purchasing the Holder’s goods in the mistaken belief that they are the goods of the Opponent or those of an undertaking economically linked to the Opponent.⁴⁰ A mere wondering whether there is a trade mark connection is insufficient.⁴¹ It is my view that the distance between the respective goods and the respective signs is insufficient for misrepresentation to arise or one that would lead to damage being suffered by the Opponent. It is unlikely that the customers of the Opponent would transfer their custom

⁴⁰ *Harrods Limited v Harrodian School Limited* [1996] RPC 697.

⁴¹ *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at 16–17

to the Holder for computer related goods and protective coverings believing that they are dealing with the Opponent which has goodwill in relation to energy drinks.

129. Without misrepresentation there can be no damage, consequently, the opposition under section 5(4)(a) fails.

Conclusion

130. The opposition is partially successful under section 5(2)(b) but fails in its entirety in relation to the grounds brought under sections 5(3) and 5(4)(a). Subject to appeal the UK designation to protect the International Registration in the UK no. 1668629 shall proceed to registration but only for the following goods:

Class 9: Computers, notebook computers, laptop computers, tablet computers, computer mice, mouse pads [computer peripheral].

131. The UK designation to protect the International Registration in the UK no. 1668629 shall be refused for:

Class 9: laptop carrying cases, sleeves for laptops, notebook computer carrying cases, cases adapted for notebook computers.

Costs

132. I consider that the Holder has had the greater share of success overall and is therefore entitled to a contribution towards its costs based on the scale outlined in TPN 1/2016. The Opponent having succeeded in part has requested that I consider an off scale costs award in its favour because it considered that the Holder's conduct in requesting that it prove the reputation and goodwill it claimed to hold was unreasonable. It asked me to take this into account in making any costs award.

133. In this regard I do not consider that the Holder's conduct can be found to amount to unreasonable behaviour. It is my view that upon receipt of an opposition in which a reputation and goodwill is claimed, for a broad range of goods and services and numerous marks, it remains open to a party to require the other to prove its case by the filing of evidence. The Holder was entitled to take such a course of action and ask the Opponent to prove its case. I note that the Opponent's reputation only extended to a narrow subcategory of goods whilst its pleadings relied on much broader terms. Whilst it was open to the Holder to concede the point and not put it to proof for energy

drinks there was no obligation for it to do so. Had the Opponent sufficiently particularised its pleadings identifying the scope of the reputation claimed for each of the individual marks at the beginning, the position may be different. Even in the context of the Opponent's section 5(3) and 5(4)(a) claims which were focussed on drinks and various sub categories of this term, the actual evidence filed and the basis on which I proceeded to find a reputation and goodwill was solely in relation to energy drinks. I consider the Holder was thus entitled to ask the Opponent to prove its reputation and goodwill for the broader categories relied upon which in fact they have failed to do even though in the end it was not necessary for me to make a specific finding in this regard. The approach the Holder took therefore does not in my view strike me as an abuse of process or amount to unreasonable behaviour. Nor do I consider that putting the other side to proof was a tactic to purposefully increase its costs in these proceedings.

134. For these reasons, I award costs to the Holder as set out below which I have reduced accordingly to reflect the Opponent's degree of success.

Considering the notice of opposition and preparing a defence and counterstatement:	£300
Preparing and attending a hearing:	£700
Total	£1,000

135. I order Monster Energy Company to pay FOKUS BILGISAYAR SANAYI VE TICARET LIMITED SIRKETI the sum of £1,000 as a contribution towards its costs. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an (unsuccessful) appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of June 2026

Leisa Davies

For the Registrar